

Appl. No. : 09/01,051
Filed : August 24, 2000

REMARKS

In response to the Office Action mailed February 7, 2003, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

Matters of Form

Applicant has amended Claims 4 and 25 to correct the informalities noted by the Examiner in Claims 4, 6 and 25-26.

Claim 1-7

Claim 1 stands rejected under 35 U.S.C. §102(e) as being anticipated by Kato (i.e., U.S. Patent No. 6,213,096). Claims 2 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Kamiyama (i.e. U.S. Patent No. 4,861,238). Claim 4 and 6 stand rejected under 35 U.S.C. §112 and have been amended as mentioned above. The Examiner has indicated that Claims 3 and 5 contain patentable subject matter.

To advance prosecution, Applicant has amended these claims to more distinctly and specifically recite the claimed fuel system. Specifically, Claim 1 has been amended to include an elastic conduit, similar to original dependent Claim 2, which has been canceled.

As mentioned above, Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Kamiyama. Applicant respectfully traverses the rejection of the claimed subject matter.

As stated by the Examiner, Kato is a prior art reference under 35 U.S.C. §102(e). Most subject matter that is prior art under 35 U.S.C. §102 may be used to support a rejection under 35 U.S.C. 103(a). See MPEP §2141. However, after November 29, 1999, certain types of prior art under 35 U.S.C. §102(e) cannot be used to support a rejection under 35 U.S.C. §103(a). Specifically, as set forth, in 35 U.S.C. § 103(c) :

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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At the time the present invention was invented, the invention of the present application was subject to an obligation of assignment or owned by Sanshin Kogyo Kabushiki Kaisha. At the time the invention of the Kato patent was invented, it was also subject to an obligation of assignment or owned by Sanshin Kogyo Kabushiki Kaisha. In addition, the present application was filed after November 29, 1999; thus the above version of §103(c) applies. MPEP § 2146. Consequently, for at least this reason, Kato cannot be used to reject Applicant's claims under §103.

Dependent Claims 3-7 are also in condition for allowance because they depend either directly or indirectly on allowable Claim 1 and they recite additional patentable subject matter.

Claims 13, 14, 16, 17 and 24

Claims 13, 14, 16 and 24 stand rejected under 35 U.S.C. §103(a) as unpatentable over Kato in view of Osakabe (i.e. U.S. Patent No. 5,809,974). The grounds for rejecting Claim 17 have not been stated.

Applicant's respectfully traverse the rejection of these claims. As set forth above, Kato cannot be used to render Claims 13, 14, 16 and 24 obvious under 35 U.S.C. §103; therefore, reconsideration of the grounds of rejections is respectfully requested.

Claims 25 and 26

Claim 25 stands rejected under 35 U.S.C. §102(e) as being anticipated by Kato. Claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Kamiyama.

With respect to independent Claim 25, to advance prosecution, Applicant has amended this claims to more distinctly and specifically recite the claimed fuel system. Specifically, Claim 25 now recites, in part, a fuel system comprising "means for reducing fuel pressure fluctuations within said fuel system through elastic expansion."¹ In contrast, Kato discloses a resonator 202 that comprises a chamber 203, which has a certain capacity and an orifice 204 through which the chamber 203 communicates with a fuel passage 143. Col. 12, lines 24-30. Pressure fluctuations are "smoothed" as the positive part of the pulsation pressure is received by the capacity of the chamber 203 and the negative part of the pulsation pressure is compensated by the pressure existing in the chamber 203. Col. 12, lines 30-34. As such, Kato does not discloses a fuel system that reduces fuel pressure fluctuations within said fuel system through elastic expansion. For at least this reason, Applicant submits that Claim 25 is in condition for allowance.

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As mentioned above, Kato cannot be used to render dependent Claim 26 obvious under 35 U.S.C. §103. Nevertheless, Applicant has amended dependent Claim 26 as set forth above.

Applicant respectfully requests the Examiner to reconsider Claims 25 and 26 in light of this amendment.

Claim 28

Claim 28 stands rejected under 35 U.S.C. §102(e) as being anticipated by Kato (i.e., U.S. Patent No. 6,213,096). To advance prosecution, Applicant has amended this claims to more distinctly and specifically recite the claimed fuel system. Specifically, Claim 28 now recites, in part, a fuel system comprising “a vibration damping apparatus and a pressure dampening device comprising an elastic conduit in communication with the fuel injector.” Applicant respectfully requests the Examiner to reconsider Claim 28 in light of this amendment.

Withdrawn Claims

Claims 8-12, 15 and 18-23, and 27 have been withdrawn as being drawn to a non-elected species. Applicant respectfully submits that Claims 1, 13 and 25 and are in condition for allowance and are generic to all of the species identified by the Examiner in Paper No. 4. As such, Applicant respectfully request that the withdrawn claims now be considered and allowed. These claims are in condition for allowance because, *inter alia*, they depend upon either directly or indirectly upon allowable Claims 1, 13 or 25.

Supplemental Information Disclosure Statements

Applicant respectfully requests the Examiner to consider the references cited the Supplemental Information Disclosure Statement filed with this Amendment. This Supplemental Information Disclosure Statement include three Japanese Applications that were published on October 5, 1999 and to which Kato (i.e., U.S. Patent No. 6,213,096)* claims foreign priority. Applicant respectfully notes that the above-captioned Application claims priority to Japanese Application Nos. Hei 11-236461 and Hei 11-236462, both filed on August 24, 1999.

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CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly.

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Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: 

Rabinder N. Narula
Registration No. 53,371
Attorney of Record
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(949) 760-0404

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